

REMARKS

Claims 17, 23 and 27 are canceled without prejudice, and therefore claims 16, 18 to 22, 24 to 26, 29 and 30 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

Applicants thank the Examiner for indicating that claims 17 to 22 and 24 to 26 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claim 16 has been rewritten to include the features of claim 17, which is canceled without prejudice. Claim 18 now depends from claim 16, and not canceled claim 17. Claim 29 also includes features like that of claim 17. Accordingly, claims 16 and 29 and their respective dependent claims are allowable, and it is therefore respectfully requested that the objections be withdrawn.

As to the objections to claims 16, 27 and 29, while the objections may not be agreed with, to facilitate matters, claims 16, 27 and 29 have been rewritten essentially as suggested by the Office. It is therefore respectfully requested that the objections be withdrawn.

As to the objections to claims 24 to 26, claims 24 and 25 have been rewritten as suggested by the Office. Claim 24 now depends from claim 16, since claim 23 is canceled. It is therefore respectfully requested that the objections be withdrawn.

The drawing of Figure 1 was objected to because it purportedly lacks a legend as to S1, S2, etc.

The drawings objection is traversed. In particular, while 37 C.F.R. § 1.83(a) requires the drawings to show every feature of the specified in the claims, "conventional features disclosed in the description and claims . . . should be" -- but are not required to be -- "illustrated in the drawing" "where their detailed illustration is not essential for a proper understanding of the invention." Here, the present application makes plain that as to this aspect, a detailed illustration is not essential for a proper understanding of the invention, since the present application makes plain that S1, S2, etc. refer to step 1, step 2, etc.

It is also respectfully submitted that under 37 C.F.R. § 1.81 (a) — to which § 1.83 (a) is subject — an applicant is only “required to furnish a drawing of [the] invention where necessary for the understanding of the subject matter sought to be patented.”

It is therefore respectfully requested that the drawing objection be withdrawn, since a person having ordinary skill in the art would plainly understand the references to S1, S2, etc. without a legend, which needlessly complicates the Figure and adds no information.

Claims 16, 23, 27 and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by Geier, “802.11 Beacons Revealed”.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 16 has been rewritten to include the features of claim 17, which is canceled without prejudice. Claim 18 now depends from claim 16, and not canceled claim 17. Accordingly, claim 16 and its dependent claims are allowable.

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Also, claim 29, as presented, now includes features like those of claim 17, and it is therefore allowable for essentially the same reasons as claim 16, as presented, as is its dependent claim 30.

It is therefore respectfully requested that the anticipation rejections be withdrawn.

Claim 30 was rejected under 35 U.S.C. § 103(a) as unpatentable over Geier in view of Manis, U.S. Patent Application Publication No. 2003/0133473.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 30 depends from claim 29, as presented, and it is therefore allowable for essentially the same reasons as claim 29, as presented, since the secondary “Manis” reference does not cure--and is not asserted to cure-- the critical deficiencies of the primary Geier reference.

Withdrawal of the obviousness rejection of claims 30 is therefore respectfully requested.

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Accordingly, all of pending claims 16, 18 to 22, 24 to 26, 29 and 30 are allowable.

CONCLUSION

In view of the foregoing, all of pending claims 16, 18 to 22, 24 to 26, 29 and 30 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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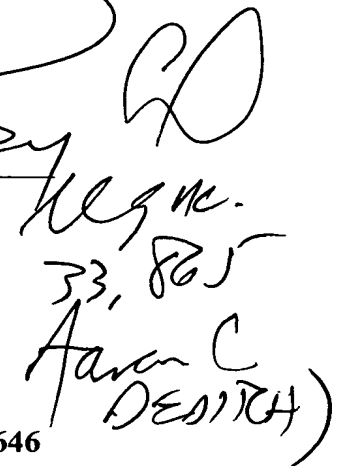
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